

BEST AVAILABLE COPY



**UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

20

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/383,724 08/26/99 CHANG

K	EXAMINER 261752000100
---	-----------------------

IM22/0801

ART UNIT	PAPER NUMBER
TARAZANO, D	

2

BARRY E BRETSCHNEIDER
MORRISON & FOESTER LLP
2000 PENNSYLVANIA AVE NW
WASHINGTON DC 20006-1888

DATE MAILED:
1773

08/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/383,724

Applicant(s)

CHANG ET AL.

Examiner

D. Lawrence Tarazano

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 7.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Priority

If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1- 8 of copending Application No. 09/383,731. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims the same basic structure and materials. Furthermore, the films provide the same function. The only difference is that 09/383,731 also claims a microcrystalline wax component.

Art Unit: 1773

3. First, the instant claims do not require such material and would be open to the presence of such additives.

4. Second, while claims 1-8 of 09/383,731 require a lubricating wax, films of this type are known to include such wax materials as lubricants. This is shown by Balloni et al.'125, who teach oriented polypropylene films, which comprise microcrystalline wax additives and aluminum silicate anti-blocking agents (example 1). They teach that anti-blocking agents having a particles size of 0.5 to 5 microns, and that they are used in amounts of 0.005 to 0.5% (column 4, lines 28+). They further teach that microcrystalline waxes are used and that the materials that they use have a melting point of 85-165° C (185-329° F), (column 4, lines 28+). Example 1 shows that B² 195 microcrystalline wax is a useful material. These wax materials in combination with the other materials used produce films having good coefficient of friction and anti-stick properties (column 3, lines 40+, column 4, lines 28+).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used wax as taught by Balloni et al.'125 in the films claimed in the instant application since wax materials of this type improve the lubricating properties of such films.

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1773

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims the applicants use the term "polyolefin-based" and "polypropylene-based". The use of the modifier "based" makes the claims indefinite. It is unclear if the applicants intend to these materials just to be polyolefins or polypropylene, or if the applicants intend to include addition materials which comprise these types of monomers and additional monomers such as unsaturated esters, unsaturated acids, etc... It is unclear how these terms should be interpreted.

Starting with line 10 of claim 1 and continuing to line 13, it is not clear what materials are present and what materials are optional or alternative.

Regarding claims 7 and 8, it is not clear how the scope of these claims differ, they appear to be claiming the same subject matter. Are the applicants claiming a blend of aluminum-silicates in claim 7? The examiner asks for clarification on this matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balloni et al. (4,659,612) in view of Balloni et al (4,590,125) and Kondo et al. (5,271,976).

Balloni et al. '612:

Art Unit: 1773

Balloni et al.'612 teaches a three layer film comprising surface layers (a) and (c) containing: polypropylene, and anti-blocking agents; and the top surface layer (a) further comprises silicone oil. These films are surface modified by corona discharge or flame treatment to give the surfaces better reception to aqueous coatings (column 4, lines 64+). The films have a general thickness of 0.35 to 2.0 mil (0.35 to 50.8 microns) in which the core layer (b) makes up 70-90% of the films leaving each of the surface layers have a thickness of 15-5% of the total thickness of the film. Thus, layers (a) and (c) have thickness ranges of 0.0175 to 7.62 microns. For these reasons, the thickness of each of the applicants' two layers overlap with the range taught.

Anti-blocking Agents: Layers (a) and (c) comprise anti-blocking agents such as silicates (column 3, lines 48+) in effective amounts such as 0.2% (examples).

Silicone Oil: Layer (a) comprises an effective amount of silicone oil having a viscosity of 350 to 2,500,000 centistrokes, in amounts of 0.15 to 1.5% (column 3, line 62 to column 4, line 48)

Balloni et al.'612 is silent regarding the use of aluminosilicates and the properties of these materials, and the nature of the silicone oil used.

Balloni et al.'125:

Balloni et al.'125 teach oriented polypropylene films comprising aluminum silicate anti-blocking agents (example 1). They teach that anti-blocking agents having a particles size of 0.5 to 5 microns, and that they are used in amounts of 0.005 to 0.5% (column 4, lines 28+).

Kondo et al:

Art Unit: 1773

Kondo et al. teach the advantages of using 0.25% amorphous aluminosilicate anti-blocking agents having an average particle size of 2 microns in multilayer polypropylene films (Example 3).

Reasons to Combine:

Regarding claims 1, 7, and 8: It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used aluminum silicate anti-blocking agents (corresponding to the applicants' claimed amorphous aluminosilicate") materials as taught by Balloni et al.'125 or Kondo et al. in the films taught by Balloni et al.'612 since these are useful "silicate" anti-blocking materials. Regarding claim 7, Balloni et al.'612 or Kondo et al. uses anti-blocking agents having a diameter of 2 microns; this is within the claimed range. Since these are the same size, and since amorphous aluminosilicate are the same materials, they would have essentially the same packing density. Therefore, there is reason to believe that they would have bulk densities in the claimed range.

It is held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). When there is sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

Art Unit: 1773

Regarding claims 2 and 4: It would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the thickness ranges. It is held that choosing the overlapping portion, of the range taught in the prior art and the range claimed by the applicant, has been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549.

Furthermore, the thickness of the layers would relate to the overall thickness of the films and would relate to the end use of the packaging films and economics. Thicker films would be stronger than thinner ones but more expensive to produce because they use greater amounts of raw materials.

Regarding claims 3 and 5: While the applicants state the layers “consists essentially of polypropylene”, this does not preclude the presence of additional materials. It is held that when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of”, the applicants have the burden of showing that the introduction of additional steps or components would materially change the characteristics of the applicants’ invention. *In re DeLajarte*, 337 F. 2d 870, 143 USPQ 256 (CCPA 1964). In the absence of probative evidence to the contrary, the applicants’ claims are open to the presence of other materials including those taught in the prior art.

The examiner also notes that the applicants do not preclude the presence of additional layers including the core layer of the prior art. There is no requirement that the two layers are directly adhered to each other.

Regarding claim 6: The applicants claim silicone oils having: a viscosity of 300-400 centistokes (cSt), a specific gravity at 77°F of 0.90 to 0.99, and a volatile content of 0.001 to 0.005%. The prior art teaches silicone oils having a viscosity of 350 to 2,500,000 centistokes.

The prior art teaches viscosities that overlap with those claimed, and the applicants have shown no criticality to the claimed range. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected silicone oils with in the overlapping portion of the range since these materials provide desirable lubricating properties.

The applicants claim a wide range of specific gravities. Since both the prior art and the applicants are using the same types of materials, the densities would be the same. With respect to the amount of volatiles present, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have choose silicone oils having low amount of volatile components. This would limit the amount of silicone oil volatized in the production and use of the films, which would limit contamination by volatile silicone oil of the equipment and people operating it.

Conclusion

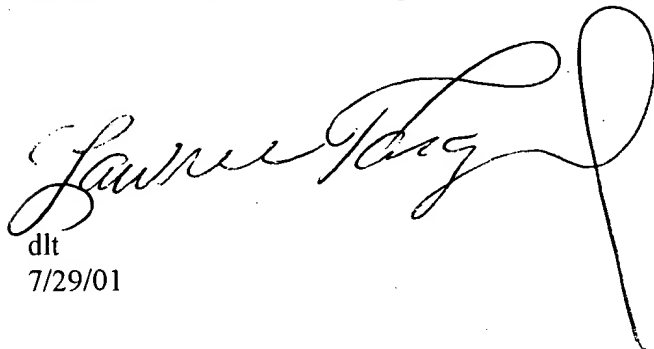
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner cites Azuma et al. (4,785,042) to show the properties of amorphous aluminosilicates.

Art Unit: 1773

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.



dlt
7/29/01

D. L. Tarazano
Examiner
Art Unit 1773